

REMARKS

Claims 1-6 are pending in the current application and all claims herein are drawn to elected Group I. The specification and drawings have been amended to correct minor errors noted in the Office Action and otherwise.

Claims 1 and 3 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention.

Claims 2 and 5 have been cancelled, without prejudice.

New claim 10 also particularly points out and distinctly claims subject matter regarded as the invention.

The amendments here presented are made for the purposes of better defining the invention, rather than to overcome the rejections for patentability. Support for the amendments herein presented can be found in the specification and claims as filed. No new matter has been introduced as a result of the amendments. Reconsideration and allowance is respectfully requested in view of the amendments and the following remarks.

Informal Objections

The drawings are objected to under 37 CFR 1.83(a). The Office Action at paper number 7 paragraph 1 objects to the power supply electrode being absent. The FIG. 1 has been amended to include the numerals 3 and 7 clearly defining the elements as claimed. The power supply electrode 7 is included in the drawings as amended.

The ABSTRACT of the disclosure is objected to for being outside the range of 50-150 words. The ABSTRACT has been amended as shown above.

The third paragraph at page 7 was objected to as having an improper capitalization. The third paragraph at page 7 has been amended as shown above.

The above amendments are believed to address the objections in the Office Action.

Objection to Specification

The specification stands objected to under 35 U.S.C. § 112, first paragraph, as allegedly failing to disclose the invention in such terms as would allow one of ordinary skill in the art to practice the invention. This objection is respectfully traversed.

The Office Action at paper number 7, paragraph 6 asserts that the independent claim 1 recites a power supply electrode that applies a voltage to the electrode as well as the specification discloses in the third paragraph at page 7 that the apparatus 10 is equipped with power supply electrode 7. The Office Action asserts that it is not clear to one skilled in the art as to how the recited or disclosed electrode can apply a voltage to the electrostatic adsorption electrode. Applicants respectfully disagree with the assertion in the Office Action.

The Figure 1A has been amended to include the numerals 3 and 7. Additionally, the specification clearly teaches at page 7, paragraphs 2-4 and into page 8 paragraphs 1-2, that the positive electrode 1 and the negative electrode 2 have their respective portions interconnected. Also reference Figures 1A and 2. Thus, one skilled in the art clearly understands how the voltage is applied to the respective electrodes in the claimed invention.

With this amendment it is respectfully submitted the claims satisfy the statutory requirements.

The 35 U.S.C. § 112 Rejection

Claims 1-3 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. This objection is respectfully traversed.

The Office Action at paper number 7, paragraph 8 asserts that the phrases “the adsorption surface” and “the plastic film” lack proper antecedent basis. The phrase “that applies” is indefinite for its reference to a method of operating the device. At claim 2 the phrase “employs” is indefinite for reference to a method of operating the device. At claim 3 the phrase “the positive electrode” lacks antecedent basis.

Claims 2 has been deleted. Claim 1 has been amended to include proper antecedent basis and thus claim 3 has proper antecedent basis from amended claim 1. The phrases “that applies” and “employs” have been amended to include structural

language. With this amendment it is respectfully submitted the claims satisfy the statutory requirements.

Withdrawal of the 35 U.S.C. § 112, second paragraph rejection is respectfully requested.

The 35 U.S.C. § 103 Rejection

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being allegedly unpatentable over Honma et al. (U.S. Patent No. 5,748,436) in view of JP 07-297265. This rejection is respectfully traversed.

In the Office Action at paper number 7, paragraph 10, the Office Action asserts that Honma's invention is directed to an electrostatic chuck for electrostatically clamping a working member to the chuck. The Office Action asserts that Honma discloses in Fig. 3 that the chuck comprises an electrostatic adsorption electrode, an insulated dielectric layer covered by the electrostatic adsorption electrode, and a power supply. The Office Action admits that there are differences between the cited reference of Honma and the claims. The differences being the setting of the recited roughness of the adsorption surface of the dielectric layer, and the intended use of the chuck. The Office Action asserts that JP'265 shows in an electrostatic chuck the setting of roughness on the adsorption surface of the dielectric layer to be 0.25µm or below which is within the recited range. The Office Action asserts that the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Honma's teachings as suggested by JP'265 because this would result in obtaining an electrostatic chuck having a quick response characteristic and excellent performance.

The Office Action also asserts that use of the chuck for processing plastic film, the subject matter as a whole would have been obvious to modify the references because it has been held that apparatus claims cover what a device is and not what a device does. (15 USPQ 2d 1525).

The Office Action asserts with respect to claim 3 that the recited ratio of the interval and the thickness would have been within the level of the skill in the art.

The Office Action asserts with respect to claims 4, 5, or 6 that the recited volumetric resistivity of the dielectric layer is disclosed by Honma between 10^8 to 10^{13} Ωcm which overlaps the recited range. Applicants respectfully disagree with the assertions in the Office Action.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

The Honma et al. reference in combination with the JP 07-297265 reference fail to teach or suggest all of the claimed elements. The Honma et al. reference in combination with the JP 07-297265 reference do not teach or suggest a plastic film electrostatic adsorption apparatus comprising an electrostatic adsorption electrode, an insulated dielectric layer that covers the above electrostatic adsorption electrode and has a center line average roughness of an adsorption surface on which a plastic film is placed of 0.5 μm or less; and a power supply electrode configured to apply a voltage to the above electrostatic adsorption electrode wherein the electrostatic adsorption electrode comprises a bipolar structure having a positive electrode and negative electrode, and is characterized by an outermost end being homopolar, at least as claimed in amended claim 1.

With respect to the functional limitations in claims 1 and 2, the amendment provides for structural limitations that specifically claim the metes and bounds of the claimed invention that are given patentable weight.

Since the rejection has been traversed, it is respectfully requested that the Examiner provide specific citation or an affidavit providing evidence to support the Office Action assertions.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Dependent Claims

The argument and evidence set forth above is equally applicable here. Since the independent Claim 1 is allowable, then the dependent Claims 3, 4, and 6 must also be

allowable. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988).

New claim 10 includes claimed subject matter that the prior art references fail to teach or suggest. Specifically, the combination of the Hanma and JP 07-297265 references fail to teach or suggest a plastic film electrostatic adsorption apparatus comprising an electrostatic adsorption electrode, an insulated dielectric layer that covers said electrostatic adsorption electrode, said insulated dielectric layer comprising a center line average roughness of an adsorption surface on which a plastic film is placed of 0.5 μm or less, and a power supply electrode configured to apply a voltage to the above electrostatic adsorption electrode wherein the electrostatic adsorption electrode comprises a bipolar structure having a positive electrode and negative electrode, said positive electrode and said negative electrode having portions alternately disposed.

In view of the foregoing, it is respectfully requested that the rejection be withdrawn and it is respectfully asserted that the claims are now in condition for allowance.

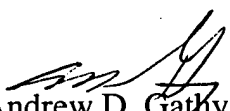
Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.

Dated: Oct 20 2003


Andrew D. Gathy
Reg. No.: 46,441

Sierra Patent Group
P.O. Box 6149
Stateline, NV 89449
(775) 586-9500